

REMARKS

This is in full and timely response to the Official Action of October 18, 2005. The present Amendment adds new claims 20 and 21, which depend from independent claim 6. No new matter has been added. Accordingly, claims 6 and 8-21 are presently pending in the application, each of which is believed to be in condition for allowance. Reexamination and reconsideration in light of the present Amendment and the following remarks are respectfully requested.

New Claims

Support for new claims 20 and 21 can be found variously throughout the specification, including, for example, page 17, lines 3-11, page 46, Table 4, page 54, Table 6, and original claim 8.

New claim 21 claims a sintered contact material containing non-metallic particles comprised of one or more substances selected from the group consisting of carbides, nitrides, and carbonitrides. The prior art does not disclose or suggest the addition of carbides, nitrides, or carbonitrides, which are shown in examples to lead to an increase in the sliding properties of the contact material. For instance, the addition of TiN particles led to a considerable improvement in the PV value and wear resistance of the material in Table 4.

New claim 20 claims a sintered contact material containing non-metallic carbide particles. The carbide particles are not disclosed in the prior art, and as indicated in Table 6, impart an improvement in the PV value and wear resistance of the contact material.

Since each of these new claims is clearly distinguishable from the applied art of record, allowance of the same is courteously solicited.

Claim Rejections – 35 U.S.C. § 102

In the Action, claims 6, 8-10, and 12 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Takayama '549 et al. (US Patent No. 5,948,549). This rejection is respectfully traversed.

Independent claim 6 of the present application recites a copper based sintered contact material, wherein, *inter alia*, the total amount of **intermetallic compounds** is 0.1 to 10% by volume.

In contrast, Takayama '549 fails to disclose, teach or suggest the total amount of **intermetallics compounds** being equal to 0.1 to 10% by volume, as is recited in claim 7 of the present application. In fact, the Action has conceded that "Takayama '549 is silent as to the volume % of intermetallics in the contact", thereby rendering the § 102 rejection of claim 7 ineffective. *See* pg. 5 of Action.

The Office Actions suggests that intermetallic compounds are likely present in Takayama '549 due to the presence in the starting mixture of individual elements capable of forming intermetallics. However, as conceded by the Examiner, it is not certain that the recited elements of Takayama '549 would form into intermetallics, and the disclosure provides no evidence that the elements would form into intermetallics. In fact, Takayama '549 does not even suggest that intermetallics are formed during the sintering process, but rather indicates that intermetallic compounds, such as NiAl or FeAl may be added to the mixture, with a maximum total amount of 3.0 wt% intermetallic compounds being added in any of the examples (col. 10, lines 5-22 and Table 3).

The present application further supports the desirability of adding intermetallics for the purpose of improving the sliding properties of the sintered contact material. For instance, the present specification (page 30, lines 16-21) states that the addition of Cr, Mo, and W in a large amount leads to a **marked improvement in high-speed sliding properties**.

Accordingly, because Takayama '549 fails to disclose, teach or suggest each and every limitation of claim 7, a *prima facie* anticipation rejection has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference").

Moreover, aside from the novel limitations recited therein, claims 8-10 and 12, being dependent either directly or indirectly upon allowable base claim 7, are also allowable at least by virtue of their dependency upon allowable claim 7. Withdrawal of the rejection of these claims is therefore courteously solicited.

Moreover, aside from the novel limitations recited therein, claims 8-10, and 12, being dependent either directly or indirectly upon allowable base claim 6, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore courteously solicited.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 13-19 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over by Takayama '549 et al. (U.S. Patent No. 5,948,549). Additionally, claim 11 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Takayama '775 (U.S. Patent No. 6,015,775). These rejections are respectfully traversed.

Aside from the novel limitations recited therein, claims 13-19, being dependent either directly or indirectly upon allowable base claim 6, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore courteously solicited.

Conclusion

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KOM-0153/INO/DIV2 from which the undersigned is authorized to draw.

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Respectfully submitted,

By _____
Ronald P. Kananen
Registration No.: 24,104
Attorney for Applicant

RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W. Suite 501
Washington, D.C. 20036
Tel: (202) 955-3750
Fax: (202) 955-3751
Customer No. 23353